

REMARKS

Applicants have carefully reviewed the Office Action of February 9, 2005. Claims 38-49 and 51-52 are pending and have been rejected. Applicants respectfully traverse the rejections.

***Claim Rejections—35 U.S.C. § 102***

Claims 38-41, 43, 45-49 and 51-52 were rejected under 35 U.S.C. § 102(b) as being anticipated by Gelbfish (U.S. Patent No. 5,800,457).

Gelbfish discloses a distally facing intravascular filter that is attached or attachable to a rod via a hook at the distal end of the rod. Gelbfish does not disclose "a guidewire having...a stop proximal the distal end," a feature recited in claim 38.

An illustration of Fig. 3C of Gelbfish is helpfully provided on page 3 of the Office Action. It appears from this illustration that the Examiner regards a proximal part of hook 44 as the stop and a distal part of the hook as not part of the stop. Otherwise, the stop (i.e. the hook) could not be regarded as proximal the distal end of the guidewire. Applicants are unable to discern any reasonable grounds for asserting that the proximal portion of the hook alone is the stop without including the distal portion of the hook. If one removes the distal part of the hook, the hook is no longer a hook.

The fact that a certain characteristic may be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See MPEP 2112 and *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent

characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Because of this, the hook in its entirety must be treated as corresponding to the stop of claim 38 when analyzing Gelbfish as a potentially anticipatory reference. However, when one does this, it is clear that the stop is not proximal the distal end of the guidewire, as it must be to anticipate the claim; the stop is in fact the distalmost portion of the guidewire. Gelbfish, therefore, cannot anticipate claim 38.

Because Gelbfish does not disclose each and every element of claim 38, applicants submit that claim 38 is in condition for allowance. As claim 51 depends from claim 38 and contains additional elements, applicants submit that claim 51 is also in condition for allowance.

Claim 39 also recites "a guidewire having ...a stop proximal the distal end." For the reasons discussed above with respect to claim 38, applicants submit that Gelbfish does not disclose this feature and consequently that claim 39 is in condition for allowance. As claims 40-41, 43, 45-48 and 52 depend from claim 39 and contain additional elements, applicants submit that these claims are in condition for allowance as well.

#### ***Claim Rejections—35 U.S.C. § 103***

Claim 49 was rejected under 35 U.S.C. § 103(a) as being obvious over Gelbfish. Applicants respectfully traverse the rejection.

Claim 49 depends from claim 39, which applicants submit is allowable, and contains additional elements. For this reason, applicants submit that claim 49 is also in condition for allowance.

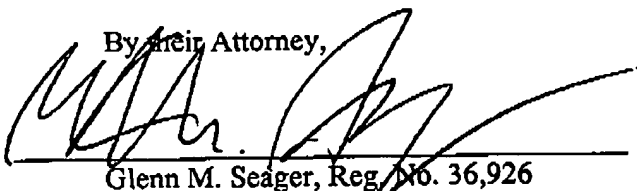
In view of the amendments and comments presented herein, favorable reconsideration in the form of a Notice of Allowance is respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

ROSS TSUGITA ET AL.

By their Attorney,

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Glenn M. Seager, Reg. No. 36,926  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, Minnesota 55403-2420  
Tel: (612) 677-9050